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EXAMINER

VENKAT, JYOTHSNA A

ART UNIT	PAPER NUMBER
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1615

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12/31/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/796,082

Applicant(s)

MAUBRU ET AL.

Examiner

JYOTHSNA A. VENKAT Ph. D

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 29 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) 32-37 and 80-84 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4, 5, 7-9, 27, 36, 51, 53, 55, 57, 60-62, 64, 66 and 73 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 5/10/04 and 10/29/07 12/17/07
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

Continuation of Disposition of Claims: Claims pending in the application are 1, 2, 4-5, 7-9, 27, 32, 36, 37, 51, 53, 55, 57, 60-62, 64, 66, 73, and 81-84

**DETAILED ACTION**

Receipt is acknowledged of election and amendment filed on 10/29/07. Receipt is also acknowledged of IDS file don 3/10/04 and 10/29/07. Claims 3, 6, 10-26, 28-31, 33-35, 38-50, 52, 54, 56, 58-59, 63, 65, 67-72, and 74-79 have been canceled as per applicants amendment dated 10/29/07. Claims 1, 2, 4-5, 7-9, 27, 32, 36, 37, 51, 53, 55, 57, 60-62, 64, 66, 73, and 80-84 are pending in the application and the status of the application is as follows:

***Election/Restrictions***

Applicant's election of group I in the reply filed on 10/29/07 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 80-84 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 10/29/07.

Applicant's election of species (calcium carbonate) belonging to solid particle in the reply filed on 10/29/07 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Applicant's election of species polyethyleneimine belonging to polymer chosen from cationic and amphoteric polymer in the reply filed on 10/29/07 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the

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restriction requirement, the election has been treated as an election without traverse

(MPEP § 818.03(a)).

Claims 32 and 37 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 10/29/07.

Claims 1, 2, 4-5, 7-9, 27, 36, 51, 53, 55, 57, 60-62, 64, 66, and 73 are pending in the application and the status of the application is as follows:

### *Priority*

If applicant desires to claim the benefit of a prior-filed application under 35 U.S.C. 119(e) (60/454,620 in French), Applicant must provide a certified English translation of the provisional applications. Further, a specific reference to the prior-filed application in compliance with 37 CFR 1.78(a) must be included in the first sentence(s) of the specification following the title or in an application data sheet. For benefit claims under 35 U.S.C. 120, 121 or 365(c), the reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of the applications.

If the instant application is a utility or plant application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the specific reference must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. If the application is a utility or plant application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the specific reference must be submitted during the pendency of the application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A benefit claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed benefit claim under 35 U.S.C. 119(e), 120, 121 and 365(c). The petition must be accompanied by (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted), (2) a surcharge under 37 CFR 1.17(t), and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be

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addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

If the reference to the prior application was previously submitted within the time period set forth in 37 CFR 1.78(a), but not in the first sentence(s) of the specification or an application data sheet (ADS) as required by 37 CFR 1.78(a) (e.g., if the reference was submitted in an oath or declaration or the application transmittal letter), and the information concerning the benefit claim was recognized by the Office as shown by its inclusion on the first filing receipt, the petition under 37 CFR 1.78(a) and the surcharge under 37 CFR 1.17(0) are not required. Applicant is still required to submit the reference in compliance with 37 CFR 1.78(a) by filing an amendment to the first sentence(s) of the specification or an ADS. See MPEP § 201.11.

### ***Information Disclosure Statement***

In the IDS dated 3/10/04, the foreign patents have been crossed out since the examiner considered the English equivalent and abstracts cited under NPL section.

In the IDS dated 10/29/07, the foreign patents have been crossed out since the examiner considered the English equivalent and abstracts cited under NPL section.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 2, 4-5, 7-9, 27, 36, 51, 53, 55, 57, 60-62, 64, 66, and 73 are rejected under 35 U.S.C. 103(a) as being obvious over **commonly owned U. S. Patent 7,258,852 ('852) or US 2003/0108503('503) or US 2003/0103927('927) or US 2004/0001796('796) or US 2003/0103929('929) all taken individually and combined with US 2004/0197356('356) or US 2004/0197355('355).**

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2).

*The instant application is claiming a cosmetic composition comprising:*

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*1. At least one cross-linked copolymer comprising at least one methacrylic acid unit and at least one C1-C4 alkyl acrylate unit,*

*2. Polyethyleneimine, and*

*3. Particles comprising at least 10% by weight of calcium carbonate*

*4. Silicone (claims 57, 60 and 62)*

*5. One agent beneficial to keratin material (claims 61 and 64)*

*6. Surfactant (claim 66)*

Patent '852 teaches cosmetic compositions containing a methacrylic acid copolymer, which is ingredient 1 at col.2, line 5 to col.3m line 8 and teaches cationic and amphoteric polymers at col.3, line 60 to col.10, line 5 and see col.10, line 2 for ingredient 2, see col.15, ll 5-10 for the weight percent of ingredient 2, see col.15, line 11 to col.19, line 51 for ingredient 6, and see col.19, line 58 for ingredient 4 and see the same column ll 53-61 for ingredient 5 and see col.21, ll 50-65 for application to keratin materials.

PGPUB ('503) teaches cosmetic compositions comprising ingredient 1, 2 and 4-6. see the title, see the abstract, see paragraphs 20-32 for ingredient 1, see paragraphs 36-79 for ingredient 4, see paragraphs 80-151 for the cationic polymer and see paragraph 151 for the elected species belonging to cationic polymer, which is ingredient 2, see paragraphs 245-315 for ingredient 6 and see paragraph 317 for ingredient 5 and see paragraphs 323-324 for various applications and see also paragraphs 336-339 for application of the compositions to keratin material.

PGPUB ('927) teaches cosmetic compositions comprising ingredient 1, 2 and 4-6. see the title, see the abstract, see paragraphs 16-27 for ingredient 1, see paragraphs 28-37 for ingredient 4, see paragraphs 38-107 for the cationic polymer and see paragraph 108



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for the elected species belonging to cationic polymer, which is ingredient 2, see paragraphs 193-270 for ingredient 6 and see paragraph 271 for ingredient 5 and see paragraphs 290-293 for application of the compositions to keratin material.

PGPUB ('796) teaches cosmetic compositions comprising ingredient 1, 2 and 4-6. see the title, see the abstract, see paragraphs 14-29 for ingredient 1, see paragraphs 51-60 for ingredient 4, see paragraphs 63-129 for the cationic polymer and see paragraph 130 for the elected species belonging to cationic polymer, which is ingredient 2, see paragraphs 187-258 for ingredient 6 and see paragraph 259-260 for ingredient 5 and see paragraphs 277-282 for application of the compositions to keratin material.

PGPUB ('929) teaches cosmetic compositions comprising ingredient 1, 2 and 4-6. see the title, see the abstract, see paragraphs 12-26 for ingredient 1, see paragraphs 27-36 for ingredient 4, see paragraphs 37-104 for the cationic polymer and see paragraph 105 for the elected species belonging to cationic polymer, which is ingredient 2, see paragraphs 165-238 for ingredient 6 and see paragraph 239 for ingredient 5 and see paragraphs 257-259 for application of the compositions to keratin material.

The above PGPUB documents do not teach ingredient 3 which is calcium carbonate particles.

However, PGPUB ('356) teaches cosmetic compositions comprising ingredient 3-6. See the title, see the abstract, see paragraphs 21-30 for ingredient 3, see paragraphs 44-70 for ingredient 4, see paragraphs 71-91 for the cationic polymer, see paragraphs 35-43 for ingredient 6 and see paragraph 99 for ingredient 5 and see paragraphs 104-105 for application of the compositions to keratin material.

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PGPUB ('355) also teaches cosmetic compositions comprising ingredient 3 and 5-6. See the title, see the abstract, see paragraphs 22-31 for ingredient 3, see paragraphs 44-70 for ingredient 4, see paragraphs 61-80 for the cationic polymer, see paragraphs 35-60 for ingredient 6 and see paragraph 88, 90 for ingredient 5 and see paragraphs 93-94 for application of the compositions to keratin material.

Accordingly it would be obvious to one of ordinary skill in the cosmetic art to prepare another cosmetic compositions by combining the ingredients 1-2 and 4-6 of U. S. Patent 7,258,852 ('852) or US 2003/0108503('503) or US 2003/0103927('927) or US 2004/0001796('796) or US 2003/0103929('929) and combine it with calcium carbonate particles taught by US 2004/0197356('356) or US 2004/0197355('355) in analogous cosmetic compositions. It is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose. The idea of combining them flows logically from their having been individually taught in the prior art.

Claims 1, 2, 4-5, 7-9, 27, 36, 51, 53, 55, 57, 60-62, 64, 66, and 73 are rejected under 35 U.S.C. 103(a) as being obvious over the combination of U. S. Patents 6,635,702 ('702) and 5,580,494 ('494) and WO documents WO /2002/096,385 ('385) and WO /2002/096,377 ('377)

WO /2002/096,377 ('377) corresponds to **US 2004/0197355('355)** and WO /2002/096,385 ('385) corresponds to **US 2004/0197356('356)**. **Examiner is relying on the PGPUB documents for teaching of particles claimed.**

*The instant application is claiming a cosmetic composition comprising:*

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*1. At least one cross-linked copolymer comprising at least one methacrylic acid unit and at least one C1-C4 alkyl acrylate unit,*

*2. Polyethyleneimine, and*

*3. Particles comprising at least 10% by weight of calcium carbonate*

*4. Silicone (claims 57, 60 and 62)*

*5. One agent beneficial to keratin material (claims 61 and 64)*

*6. Surfactant (claim 66)*

Patent '702 teaches aqueous surfactant compositions using the ingredients 1, and 4-6. Patent '702 teaches ingredient 1 as a rheology modifier. See the abstract for ingredient 1 and silicone. See col.3, lines 20 *et seq* and see col.4, clo.5, lines 1-40 for the cross-linked polymer which is formed from the two monomers and the cross linking agent. Patent '702 also teaches surfactants at col.5, line 41 to col.6, line 60 and teaches silicones at col.7, ll 25-68. Patent at paragraph bridging cols 8-9 suggests adding insoluble compounds and this includes claimed calcium carbonate at col.8, line 60. See col.11, ll 50-53 for the additives and these belong to agent beneficial to keratin material like waxes. Patent at col.11, line 41 suggests adding cationic conditioning polymers. This is same as claimed cationic polymer. Patent also teaches the use of these compounds in the compositions in the form of shampoos at col.11, last paragraph. See all the examples. Patent '702 teaches under examples shampoos. Shampoos are for treating keratin material. The difference between the patent and the instant application is the patent does not teach claimed cationic polymer polyethyleneimine or at least 10 % by weight of calcium carbonate. Patent '494 teaches shampoo compositions using the claimed cationic polymer (polyethyleneimine) along with surfactant. See the abstract, see

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col.2, ll 20-60 for the cationic polymer and see ll 61-62 for polyethyleneimine and see silicones at col.5, ll 5-45. Patent at col.6, ll 51-62 suggests adding thickeners also known as rheology modifiers to the compositions. See examples. WO documents teach using 10 % of calcium carbonate in cosmetic compositions and using these compositions for hair. WO /2002/096,377 ('377) corresponds to **US 2004/0197355('355)**. PGPUB ('355) also teaches cosmetic compositions comprising ingredient 3 and 5-6. See the title, see the abstract, see paragraphs 22-31 for ingredient 3, see paragraphs 44-70 for ingredient 4, see paragraphs 61-80 for the cationic polymer, see paragraphs 35-60 for ingredient 6 and see paragraph 88, 90 for ingredient 5 and see paragraphs 93-94 for application of the compositions to keratin material. WO /2002/096,385 ('385) corresponds to **US 2004/0197356('356)**. PGPUB ('356) teaches cosmetic compositions comprising ingredient 3-6. See the title, see the abstract, see paragraphs 21-30 for ingredient 3, see paragraphs 44-70 for ingredient 4, see paragraphs 71-91 for the cationic polymer, see paragraphs 35-43 for ingredient 6 and see paragraph 99 for ingredient 5 and see paragraphs 104-105 for application of the compositions to keratin material.

Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to prepare compositions of patent '702 and add calcium carbonate and polyethyleneimine (cationic polymer) expecting beneficial effect to the hair. One of ordinary skill in the art would be motivated to add the cationic polymer and panthenol into the compositions of '702 expecting that the compositions which has the acrylic acid/alkylacrylate polymer provides acceptable rheology without significant increased or decrease in viscosity or pH, with no separation settling with extended periods of time and adding the polyethyleneimine into the compositions provide the a

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conditioning effects which is excellent for the keratin and adding calcium carbonate particles would provide the additional benefit of better hair style hold and increased sensation of thickness to the hair. This is prima facie case of obviousness.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A. VENKAT Ph. D whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Friday, 10:30-7:30:1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL WOODWARD can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

**/JYOTHSNA A. VENKAT/ Ph. D**  
**Primary Examiner**  
**Art Unit 1615**